

In re application of : Neff at al.  
Application No. : 10/086,116  
Filing Date : February 26, 2002  
Examiner : Akintola, Olabode  
Title : Electronic Bartering System with Facilitating Tools

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### **REMARKS**

This Amendment is being filed in response to the Final Office Action dated August 5, 2008. This Amendment is timely filed.

Applicants respectfully request entry of this Amendment and Response.

#### **Status of Application**

Claims 1-26 and 136-141 are presented for examination. Claims 1, 7, 13-15, 20, and 25-26 are independent.

Claims 1-26, 136-141 stand rejected under 35 USC 112, first paragraph, for failing to comply with the written description requirement. Claims 1-26, 136-141 also stand rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 1-26, 136 and 138 stand rejected under 35 USC 103(a) as being unpatentable over USPN 6,418,419 of Nieboer et al. in view of USPN 6,598,026 of Ojha et al. Claims 137 and 139-141 stand rejected under 35 USC 103(a) as being unpatentable over Nieboer et al. in view of Ojha et al. and further in view of USPAP 20050137964 of Nordlicht et al. Applicants respectfully submit that the rejection of claims 1-26 and 136-141 are moot in view of the remarks provided herein and the amendments to the claims.

#### **Remarks Regarding Rejection of Claims 1-26 and 136-141 Under 35 USC 112, First Paragraph**

Claims 1-26 and 136-141 stand rejected under 35 USC 112, first paragraph as failing to comply with the written description requirement. Specifically, the Office suggests that the phrase “the at least one condition allowing matching without revealing a security symbol in the order to the market maker” is not supported in the specification.

Although Applicants respectfully disagree with the Office, Applicants have amended independent claims 1, 7, 13-15, 20 and 25-26 to replace the rejected phrase with the phrases “based on at least one characteristic” and “with no symbols specified.”

The amended claims are supported in at least the following paragraphs:

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| Para. No. | Paragraph Text   |
|-----------|--|
| 279       | “A basket of securities (“basket”) is defined to be at least two different securities, grouped in any combination of descriptions or sizes. The basket tool kit may allow traders to define a basket in terms of its market <i>characteristics</i> or risk <i>characteristics</i> , including fundamental, technical, and macroeconomic factors. Traders may also use the basket tool kit to select securities from existing portfolios. The individual securities' symbols may or <i>may not be explicitly included</i> , explicitly excluded, or a combination of both. In a simple form, the basket of all utility stocks ( <i>with no symbols specified</i> ) with market capitalization greater than \$1 billion. ...” (emphasis added) |
| 299       | “It is the intention of the inventors that the basket tool kit and the contingency tool kit may be used jointly or severally with both traditional (single-security buy and sell) orders and barter orders. It is further the intention of the inventors that the marketmaker tool kit may be used with traditional (single-security buy and sell) orders, basket order, and a user bartering a basket for another basket (barter basket order”). Although the tool kit was described in detail for use with a barter order, it can also apply to the above types of orders ...”   |

The amendments to independent claims 1, 7, 13-15, 20 and 25-26 and the support provided above render this rejection moot.

Remarks Regarding Rejection of Claims 1-26 and 136-141 Under 35 USC 112, Second Paragraph

Claims 1-26 and 136-141 stand rejected under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office suggests that the phrase “the at least one condition allowing matching without revealing a security symbol in the order to the market maker” is indefinite. Amended independent claims 1, 7, 13-15, 20 and 25-26 no longer recite the rejected phrase. Accordingly, Applicants submit that the rejection moot.

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Remarks Regarding Rejection of claims 1-26 and 136-141 Under 35 USC 103(a)

The claim amendments herein are made to progress prosecution of the present application, and Applicants expressly reserve the right to argue the patentability of the original claims at a later time. As amended, independent claims 1 and 7 each now recites a method (claim 1) or system (claim 7) for responding to order flow which provides liquidity in a financial trading system where matching of orders may be performed "based on at least one characteristic" using a rule "with no symbols specified."

With respect to independent claims 13 and 14, each now recites a method (claim 13) or system (claim 14) for responding to order flow which provides liquidity in a financial trading system for orders where a rule, "with no symbols specified," operates as a filter based on at least one characteristic, and the at least one characteristic allows automatically responding to the order.

With respect to independent claims 15, 20, 25 and 26, each now recites a method (claims 15 and 25) or system (claims 20 and 26) for establishing a rule to respond to orders where the rule is formed of "at least one condition" allowing a match or generation of a contra-order "based on at least one characteristic" using rules "with no symbols specified."

Applicants submit that amended independent claims 1, 7, 13-15, 20, and 25-26 patentably distinguish applicants' invention over the prior art or record. Specifically, none of the references show or suggest, separately or in combination, the claimed methods and systems which match orders based on characteristics with no symbols specified.

The dependent claims are submitted to be patentable as both depending from patentable independent claims and as reciting patentable subject matter in their own right. Applicants expressly reserve the right to argue the patentability of the individual dependent claims at a later time.

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#### Remarks Regarding Applicability of Nordlicht

Applicants respectfully submit that Applicants taught implied orders at least as early as December 3, 1999, the filing date of US Serial No. 09/454,035, issued as US Patent No. 7,080,050. Specifically, at least at col. 8, lines 40-60, Applicants taught the concept of an implied order using the phrase “phantom” order:

“The barter matching engine 118 searches for an order that trades ORCL for RHAT in order to make a two posted order barter transaction. However, in the example, there is no posted order that trades these two stocks, so the barter matching engine 118 locates barter order 308 that trades Puma Technologies (stock symbol PUMA) 310 for ORCL 312. The barter matching engine 118 then searches for another posted barter order that trades RHAT for PUMA to find a transaction candidate. Barter order 314 meets this criteria in that RHAT 316 is traded for PUMA 318. Accordingly, barterer order 302 can be satisfied through posted barter orders 320, 308 and 314. In a preferred embodiment so as to make the multi-order transactions transparent to the barterer, barter matching engine 118 displays multi-order barterers as a single "phantom" posted barter order. The matching engine 118 creates a transaction and displays this phantom barter order in the list of matching barter candidates. The barterer simply selects the phantom barter order to finalize the multi-order barter transaction. In these examples, it is assumed that the values and other parameters set by the barterers permit all barter orders to occur.”

Accordingly, Applicants contend that Nordlicht et al. could not be properly cited as prior art against claims supported entirely by Applicants' earlier filed cases, and Applicants reserve the right to prosecute such claims.

#### Conclusion

In view of the remarks above and the amendments presented herein, Applicants believe that claims 1-26 and 136-141 are in condition for allowance and timely notice to such effect is respectfully requested. Applicants believe that a telephone conference would expedite the prosecution of the subject application. Accordingly, Applicants request an interview following the filing of this Amendment and Response, which the undersigned will schedule with the Examiner if the Examiner agrees.

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If any additional fees are due in connection with the filing of this Amendment, the Commissioner is hereby authorized to charge such additional fees to Deposit Account 02-2051, identifying Docket No. 69174-5.

Respectfully submitted,

Date: November 5, 2008

By: /Robert R. Lech/  
Robert R. Lech

Benesch Friedlander Coplan & Aronoff LLP  
41 South High, Suite 2600  
Columbus, Ohio 43215  
Tel: 614/223-9366  
Fax: 614/223-9330  
rlech@bfca.com